

REMARKS

Claims 1-6, and 11-15 are currently pending wherein claims 7-10 have been canceled.
Entry of the above-identified amendment and favorable reconsideration is respectfully requested.

In paragraph 5 of the final Office action (“Action”), the Examiner rejects claims 1-3, 11, and 12 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0046247 A1 to Iwase et al. (“Iwase”) in view of U.S. Patent Application Publication No. 2003/0072031 to Kuwata et al. (“Kuwata”). Applicants respectfully traverse this rejection.

In order to support a rejection under 35 U.S.C. § 103, the Examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness three criteria must be met. First there must be some motivation to combine the cited references. Second there must be a reasonable expectation of success. Finally, the combination must teach each and every claimed element. In the present case, claims 1-3, 11 and 12 are not rendered unpatentable by the combination of Iwase and Kuwata for at least the reason that the combination fails to disclose each and every claimed element. More specifically, the combination fails to disclose or suggest creating a user ID and password and transmitting the user ID to the mail address as claimed.

Iwase discloses a server apparatus in which a groupware is operated. The apparatus includes: a memory to store data; an interface configured to transmit data to a mobile terminal; and a controller configured to form data for transmission to the mobile terminal and separately manage the thus formed data for transmission and data among data addressed to the mobile terminal which is not transmitted to the mobile terminal and is stored in the memory when the data addressed to the mobile terminal is transmitted to the mobile terminal via the interface (See ¶ [0013] of Iwase). Iwase further discloses that a user ID and password are stored in association

with an account name and the mail address of a mobile terminal. However, nowhere in Iwase is there any disclosure or suggestion to transmitting the user ID (as recited in claims 11 and 12) or user ID and password (as recited in claim 1) to the mail address from which the electronic mail with attachment was received.

Kuwata discloses an electronic document assembly, proofing, and printing system. The system includes, among other things, an interface for allowing user to create an account by entering a username, password, account description, and valid e-mail address. (See ¶ [0049] of Kuwata). However, nowhere in Kuwata is there any disclosure or suggestion of transmitting the user ID or password to the mail address from which an electronic mail with attachment was received as claimed. Accordingly, Kuwata fails to overcome the deficiencies of Iwase.

Since Iwase and Kuwata both fail to disclose or suggest a print service system that includes transmitting the user ID (as recited in claims 11 and 12) or user ID and password (as recited in claim 1) to the mail address from which the electronic mail with attachment was received as claimed, the combination of these two references cannot possibly disclose or suggest said element. Therefore, even if one skilled in the art were motivated to combine Iwase and Kuwata, the combination would still fail to render claims 1-3, 11, and 12 unpatentable because the combination fails to disclose each and every claimed element. Reconsideration and withdrawal of the rejection of claims 1-3, 11, and 12 under 35 U.S.C. § 103 is respectfully requested.

In paragraph 7 of the Action, the Examiner rejects claims 4-6 under 35 U.S.C. § 103(a) as being unpatentable over Iwase in view of Kuwata, further in view of U.S. Patent Application

Publication No. 2002/0078159 to Petrogiannis et al. ("Petrogiannis"). Applicants respectfully traverse this rejection.

Claims 4-6 variously depend from independent claim 1. Therefore, claims 4-6 are patentable over the combination of Iwase and Kuwata for at least those reasons presented above with respect to claim 1. Petrogiannis discloses a method and system for enabling a correspondent to securely and electronically sign a document. The system of Petrogiannis includes means for generating a user ID and password and transmitting the user ID and password to a third party in an email. However, nowhere in Petrogiannis is there any disclosure or suggestion of transmitting the user ID and password to the mail address from which the electronic mail with attachment was received as claimed. Therefore, Petrogiannis fails to overcome the deficiencies of Iwase and Kuwata.

Since Iwase, Kuwata, and Petrogiannis, each fail to disclose or suggest a print service system that includes transmitting the user ID and password to the mail address from which the electronic mail with attachment was received as claimed, the combination of these three references cannot possibly disclose or suggest said element. Therefore, even if one skilled in the art were motivated to combine Iwase, Kuwata, and Petrogiannis, the combination would still fail to render claims 4-6 unpatentable because the combination fails to disclose each and every claimed element. Reconsideration and withdrawal of the rejection of claims 4-6 under 35 U.S.C. § 103 is respectfully requested.

In paragraph 9 of the Action, the Examiner rejects claims 7-10 under 35 U.S.C. § 103(a) as being unpatentable over Iwase in view of U.S. Patent Application Publication No.

2004/0054584 A1 to Boon ("Boon"). Claims 7-10 have been canceled rendering this rejection moot.

CONCLUSION

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Penny L. Caudle Reg. No. 46,607 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§ 1.16 or 1.147; particularly, extension of time fees.

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Respectfully submitted,

By *Penny Caudle #46,607*
Michael K. Mutter
Registration No.: 29,680
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant